



Docket No.: 219587US2

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 10/072,866

Applicants: Masato HAMATANI, et al.

Filing Date: February 12, 2002

For: SPECIFICATION DETERMINING METHOD,
PROJECTION OPTICAL SYSTEM MAKING
METHOD AND ADJUSTING METHOD, EXPOSURE
APPARATUS AND MAKING METHOD THEREOF,
AND COMPUTER SYSTEM

Group Art Unit: 2851

Examiner: FULLER, RODNEY EVAN

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of _____ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier

Registration No. 25,599

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

Ronald A. Rudder, Ph.D.

Registration No. 45,618

Docket No. 219587US



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
MASATO HAMATANI ET AL. :GROUP ART UNIT: 2851
SERIAL NO: 10/072,866 :
FILED: FEBRUARY 12, 2002 :EXAMINER: FULLER, RODNEY EVAN
FOR: SPECIFICATION DETERMINING METHOD,
PROJECTION OPTICAL SYSTEM MAKING METHOD ...

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

In response to the Election of Species Requirement dated October 20, 2003,
Applicants provisionally elect Species c, corresponding to Claims 35-45. Applicants make
this election based on the understanding that Applicants are not prejudiced against filing one
or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicants respectfully traverse this Election of
Species Requirement for the reason that the different species, indicated in the Election of
Species Requirement, have not been shown to be distinct in the manner required by M.P.E.P.
§816. MPEP §816 states:

The particular reasons relied on by the examiner for holding the inventions
as claimed are either independent or distinct should be concisely stated. A
mere statement of conclusion is inadequate. The reasons upon which the
conclusion is based should be given.

Since the Election Requirement fails to set forth reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct, it cannot be said to have met the requirement of MPEP §816.

In addition MPEP §806.04(f) requires:

...Claims to be restricted to different species must be mutually exclusive...

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics. This provides additional basis for traversing the Election of Species Requirement.

Furthermore, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.


Accordingly, Applicants respectfully traverse the Election of Species Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would clearly be burdensome on the Applicants to be required to file, prosecute, and maintain separate applications and patents on the identified.

Reply to Office Action dated October 20, 2003
Application No. 10/072,866

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-84 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No: 25,599
Ronald A. Rudder, Ph.D.
Registration No: 45,618

CUSTOMER NUMBER
22850

Tel. No.: (703) 413-3000
Fax No.: (703) 413-2220
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